UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,824	03/14/2002	Gerd Geisslinger	016915-0252	3370

22428 7590 01/11/2005

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
KWON, BRIAN YONG S	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/980,824	GEISSLINGER ET AL.	
	Examiner	Art Unit	
	Brian S Kwon	1614	

--The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

THE REPLY FILED 29 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _.

   Claim(s) withdrawn from consideration: _.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

VICKIE KIM
PRIMARY EXAMINER

Continuation of 2. NOTE: With respect to claims 17-18, the proposed amendments would require further search on co-administration of the glucuronidase inhibitor, a glucuronide prodrug and a glucuronidase bound to a target tissue specific substance (three way combination). Furthermore, the proposed amendment to claim 17, which now depends upon claim 10, would require a new ground of rejection(s) .

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claims 10, 12-14, 16 and 19 under 35 USC 102(e) as being anticipated by Ratain.

Continuation of 5. does NOT place the application in condition for allowance because: In response to the Examiner's rejection of the claims under 35 USC 102(b) as being anticipated by Lehnert or Scheithauer, the applicants allege that none of the prior art reference(s) (Lehner or Scheithauer) teach the instantly claimed method of treating a subject that is suffering from condition that is characterized by high human tissue glucuronidase activity.This argument is not unpersuasive at all. Throughout the specification, the applicant discloses cancer, tumour progression or metastatis formation as a condition that is characterized by high human tissue glucuronidase activity (see especially page 2, line 5 thru page 6, line 12). In other words, both the claimed treatment recipient group and the referenced treatment recipient group are identical (a subject suffering from cancer). Thus, the prior art directing the administration of same compounds to the same treatment group for the same ultimate purpose as disclosed by Applicants anticipates Applicant's claims even absent explicit recitations of the mechanism of action.
With respect to the applicant's response to the examiner's rejection of the claims under 35 USC 103(a) as being unpatentable Jouvin-Marche, the examiner maitains the original rejection.